

### **REMARKS**

Reconsideration of this application is respectfully requested.

In a sincere effort to advance prosecution, Applicants have amended the claims or added new claims as follows. Claims 150, 151 and 183 have been amended. Claim 184 has been cancelled. Claims 185-187 have been added. After entry of the above-mentioned amendments, claims 126-130, 134-136, 141-143, 150-183 and 185-187 will be pending in the application.

Claims 150 and 151 has been similarly amended as follows. Step (a) in claim 150 now calls for "contacting under hybridizable conditions" said sample with at least one compound . . ." In claim 151 as now amended, step (a) calls for "contacting under binding conditions said sample with a compound . . ." In addition, any reference to the base element B as representing a purine, or to the attachment of A to the 8-position of a purine, is not addressed in claims 150 and 151. Applicants expressly retain the right to pursue the subject matter of the C-8 purine modification in a duly filed continuation application.

Claim 183 has been amended above by substituting the correct chemical structural formula found in the instant specification, page 11, penultimate line.

Claims 185-187 have been added above in place of claim 184, the latter having been cancelled above. Claim 185 recites "the method of claim 130 wherein said microorganism is Streptococcus pyrogenes or Neisseria meningitidis and said antibiotic is penicillin." Claim 186 defines "the method of claim 130 wherein said microorganism is Staphylococcus aureus, Candida albicans, Pseudomonas aeruginosa, Streptococcus pyrogenes, or Neisseria gonorrhoeae and said antibiotic is a tetracycline." Claim 187 in turn recites "the method of claim 130 wherein said microorganism is Mycobacterium tuberculosis and said antibiotic is an aminoglycoside." Support for the subject matter of claims 185-187 is found in the instant specification, page 29, penultimate paragraph.

Before addressing the issues in the instant Office Action, Applicants and their attorneys appreciate the indication from the Examiner that any rejections and/or objections not reiterated from the previous (September 29, 1992) office action have been withdrawn, and moreover, that the instant claims are allowable over the prior art of record for reasons of record.

It is believed that the claims presented for further examination in this application clearly obviate all the remaining issues as set forth in the instant Office Action.

**The Objection and Rejection Under 35 U.S.C. §112.**

**First Paragraph**

On page 2 of the Office Action, the specification was objected to under 35 U.S.C. §112, first paragraph, as not providing support, as originally filed, for the invention as now claimed. The Examiner stated that "Claim 184 does not limit each resistance gene practice to specific microorganisms as originally filed and thus contains NEW MATTER in this increased scope indicating that any of the microorganisms contain any of the cited resistance genes."

As noted above, claims 185-187 have been added which reflect the subject matter of page 29 (penultimate paragraph) in the instant specification. Furthermore, claim 184 has been cancelled. Although Applicants have added or cancelled the foregoing claims, they nevertheless expressly retain the right to pursue subject matter directed to antibiotic drug resistance in general for all etiological agents in a subsequent and duly filed continuation application. It is believed that the addition of the three claims, 185-187, is necessary for a proper designation of the recited microorganism viz-a-viz the resistance genes. Although claims 185-187 could be incorporated into one dependent claim, it was felt that such a dependent claim would not be as readable as three separate dependent claims. If the Examiner has any objection to the addition of these three claims without the cancellation of a corresponding number of claims, Applicants are willing to re-cast claims 185-187 as a single dependent claim.

In view of the cancellation of claim 184 and the presentation of claims 185-187, Applicants respectfully request reconsideration and withdrawal of the objection and rejection under §112, first paragraph.

**The Rejection Under 35 U.S.C. §112, First Paragraph**

Claims 126-130, 134-136, 141-143 and 150-184 stand rejected under 35 U.S.C. §112, first paragraph, as the disclosure is allegedly enabling only for claims limited to modification of purines (claims moiety B) only at the 7-position of 7-deazapurines or modification of pyrimidines (claim moiety B) at the 5-position. The Examiner's remarks are set forth on page 3 of the instant Office Action.

As noted in the opening remarks of this Amendment, claims 150 and 151 have each been amended so that reference to the C-8 modification of a purine is not addressed. Applicants feel compelled to reiterate their intent to pursue the subject matter of the C-8 purine modification in a future continuation application. With the foregoing deletions to claims 150 and 151, it is believed that the ground of rejection for non-enablement has been obviated. Reconsideration and withdrawal of the rejection is respectfully requested.

**The Rejection Under 35 U.S.C. §112, Second Paragraph**

On page 3 of the instant Office Action, claim 183 stands rejected for indefiniteness under §112, second paragraph. The Examiner astutely observed on pages 3 and 4 that "the triple bonded oxygen and triple bonded carbon atoms given in the structure . . . appears to be incorrect in that the hydroxyl probably should be directed to the triple bonded carbon thus making it bonded to four atoms and also making the oxygen bonded to only two atoms. . ."

In response to this rejection, Applicants have substituted the correct structure in claim 183. Reconsideration and withdrawal of the indefiniteness rejection is respectfully requested.

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Page 9 (Amendment Under 37 C.F.R. §1.116 - May 19, 1993)

In view of the foregoing amendments, it is respectfully submitted that each of the claims presently under examination, 126-130, 134-136, 141-143, 150-183 and 185-187, is in allowable condition. Favorable action is earnestly solicited.

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### **SUMMARY AND CONCLUSIONS**

Claims 126-130, 134-136, 141-143, 150-183 and 185-187 are presented for further examination in this application. Claims 150, 151 and 183 have been amended; and claims 185-187 have been added. Claim 184 has been cancelled by this Amendment. No new matter has been introduced by any of the amendments to the claims or by the claims added hereinabove.

This Amendment is being timely filed. For the presentation of two new claims (making for a total of 48 claims) in excess of the highest number of claims previously paid for in the application (46 claims), The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite fee of \$44.00, as set forth in 37 C.F.R. §1.16(c). The Patent and Trademark Office is further authorized hereby to charge Deposit Account 05-1135 for any other fees required in connection with this Amendment and to credit any overpayment thereto.

In view of the above amendments and discussion of the issues, Applicants respectfully submit that each of claims 126-130, 134-136, 141-143, 150-183 and 185-187, is in condition for allowance. A favorable and speedy reconsideration of their rejection is requested. If any of these claims are found not to be in condition for allowance for any reason, the Examiner is respectfully requested to telephone the undersigned at (212) 856-0876, to discuss the subject application.

Respectfully submitted,



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